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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,596	12/02/2005	Randolf Von Oepen	17601.28a.1.1	1304
57360 7590 07/01/2009 WORKMAN NYDEGGER 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111				
EXAMINER				
HORNBERGER, JENNIFER LEA				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
07/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,596

Applicant(s)

VON OEPEN ET AL.

Examiner

JENNIFER L. HORNBERGER

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims numbers in the rejections have been renumbered to be consistent with the preliminary amendment submitted 07/12/2007 which was previously overlooked in the first Office Action. It is noted the claims 12-22 are the same as the originally filed claims 1-11. The rejections themselves have not changed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 12 and 16 there is an inconsistency in the language of the preamble and that of body of the claim thus making their scope unclear. The preamble recites an apparatus for delivery and deployment of an expandable stent with the expandable stent only functionally recited, e.g. for delivery and deployment of the expandable stent, thus indicating that the claims are directed to the subcombination, delivery apparatus. However, lines 5-8 positively recite the expandable stent, as an element of the invention, e.g. the expandable stent being mounted on the catheter, thus indicating that the claims are directed to the combination of the delivery apparatus and the stent. As such it is unclear whether applicant intends the claims to be drawn to the combination or the subcombination. Applicant is hereby required to indicate which, the combination (delivery apparatus and expandable stent) or subcombination (delivery apparatus) the claims are intended to be drawn and make the language consistent with this intent. For examination purposes, the claims will be considered as drawn to the combination, the delivery apparatus and stent.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Euteneuer et al. (US 5,445,646).

Regarding claim 12, Euteneuer et al. disclose an apparatus for delivery and deployment of a stent within a vessel, the stent being expandable from a delivery diameter to a deployed diameter, the apparatus comprising: a catheter (12) having a proximal end and a distal end; an expandable means (110) mounted at the distal end of the catheter and being expandable by means of a fluid pressure device, the expandable means configured to permit mounting of the stent thereon; a sheath (14) configured to be advanced over the stent and being arranged for proximal retraction to expose the stent by means of a retraction device, wherein the fluid pressure device is further arranged to operate the retraction device so that the expandable means is expanded in response to the retraction of the sheath. There is inherently a fluid pressure device for providing the fluid to expand the expandable means and to operate the retraction device (col. 9, ln. 18-32 and ln. 48-51; Fig. 12)

Regarding claim 13, Euteneuer et al. disclose wherein the retraction device comprises a cylinder-piston arrangement operated by the fluid pressure (col. 9, ln.18-32; Fig. 12).

Regarding claim 14, Euteneuer et al. disclose a control means for controlling the fluid pressure operating the retraction device and the expandable means, either concurrently or sequentially. There is inherently a control means for controlling the fluid pressure for operating the retraction device and the expandable means. Expansion of the expandable means occurs

sequentially to the retraction of the sheath since the balloon is used to seat the stent into the vessel wall (col. 9, ln. 48-51).

Regarding claim 15, Euteneuer et al. disclose a first piston of the cylinder-piston arrangement is connected to the sheath via a wire (98, 100) (col. 9, ln. 18-32; Fig. 12).

6. Regarding claim 22, Euteneuer disclose the fluid is liquid (col. 9, ln.18-32).

Allowable Subject Matter

Claims 16-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

7. Applicant's arguments filed 04/14/2009 have been fully considered but they are not persuasive. Applicants argue that Euteneuer et al. fail to disclose an expandable means mounted at the distal end of the catheter and being expandable by a means of a fluid pressure device, the expandable stent being expandable from the delivery diameter to a deployment diameter and being mounted on the catheter over the expandable means. Applicants submit that balloons (106) are optionally inflated prior to deployment to aid preventing catheter movement by frictionally engaging the vessel wall, and therefore, the stent is not mounted on the balloons (106) and balloons are inflated prior to the deployment of the stent. The examiner acknowledges and agrees with applicants' interpretation of balloons (106). However, the examiner pointed to placement balloon (110) disclosed in col. 9, ln. 48-51 as the expandable means to meet claim 12, rather than balloons (106) disclosed in col. 9, ln. 35-38. Euteneuer et al. disclose the expandable stent is mounted on the catheter over the expandable means, and the expandable means is expanded following the retraction of the sheath (col. 9, ln. 48-51).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh

06/25/2009

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734